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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,047	08/22/2001	Barry M. Epstein		7788

7590  
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01/17/2003

EXAMINER

NGUYEN, DANNY

ART UNIT	PAPER NUMBER
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2836

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/934,047

Applicant(s)

EPSTEIN, BARRY M.

Examiner

Danny Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "37C" has been used to designate both control circuit and conductor (see fig. 2H). Conductor "37C" should be "conductor 37e". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 7, 8, 10-16, 18, 19, 42-54, 56-66, 23-26, are rejected under 35 U.S.C. 102(b) as being anticipated by Lewis, Jr. et al. (USPN 4,654,746, hereinafter Lewis).

Regarding to claims 1- 3, 15, 52, 53, 59, 60, 64- 66, Lewis discloses a system for protecting a person (see fig. 2) from electrostatic discharge (ESD) comprises an electrostatic discharge conducting contact element (22) which is in time-extended contact with a person (12) who is to be protected from electrostatic discharge when in

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use; a control circuit electrically connected to the contact element, and the control circuit including a first resistor element (24a) having resistance which upon initial contact between the person and the contact element will drain some, but not all, electrostatic discharge from the contact element; Lewis does not explicitly disclose an inductor in series with the contact element, but it is known that all resistors must have a small amount inductance, therefore, it is inherent that there is an inductor coupled between the first resistor (24a) and the contact element (22)(also see col. 8, lines 1-2); and a ground circuit (26) electrically associated with the control circuit.

Regarding to claims 4, 5, 24, 25, Lewis discloses an inductor, which has a value less than one millihenry (col. 8 lines 1-2), Lewis does not explicitly disclose an inductor in series between the first resistor (24a) and the second resistor (24b), but it is known that all resistor must have a small amount inductance, therefore, it is inherent that there is an inductor coupled between the first resistor (24a) and the second resistor (24b).

Regarding to claims 7, 14, 18, 26, Lewis discloses the control circuit includes a second resistor (24b), and the resistor has a value of at least one megohm, and the first resistor has a value approximately five and sixty megohm (see col. 6, lines 16-19).

Regarding to claim 8, Lewis discloses a capacitor (see col. 4, lines 6-8).

Regarding to claims 11, 61-63, Lewis discloses the time extended contact is greater than 100 milliseconds (see col. 8, lines 61-68).

Regarding to claims 12, 13 Lewis discloses a user (12) contact element.

Regarding to claim 16, Lewis discloses a conductor electrically connecting the contact element (22) to the ground circuit (26) (see fig. 2).

Regarding to claims 19, 23, Lewis discloses a system for protecting a person (see fig. 2) from electrostatic discharge (ESD) comprises an electrostatic discharge conducting contact element (22) which is in time-extended contact with a person (12) who is to be protected from electrostatic discharge when in use; a control circuit electrically connected to the contact element, and the control circuit including a first resistor element (24a) in series with the contact element and having a resistance in excess of five megohm (see col. 6, lines 16-19); a ground circuit (26) electrically associated with the control circuit.

Regarding to claim 26, Lewis discloses the control circuit includes a second resistor (24b), and the resistor has a value of at least one megohm (see col. 6, lines 16-19).

Regarding to claims 10, 42-44, 48, 49, Lewis discloses a system for protecting a person (see fig. 2) from electrostatic discharge (ESD) comprises a user contacting device (keyboard 20) having a plurality of user contacting locations; an electrostatic discharge conducting contact element (space bar key, enter key, shift key...) at each user contacting location of the plurality of user contacting locations and which contact a user in a time extended manner when in use; a control circuit electrically connected to each of the contact element (such as space bar key which has the same structure as protective device 10) and including a first resistor having resistance that is sized to upon initial contact between the user and the contact element drain some, but not all, electrostatic discharge from the contact element; and a ground circuit (26) electrically associated with the control circuit.

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Claims 45, 46, 56, 58, repeat limitations of claims 1, 8 and 18, therefore rejected accordingly.

Regarding to claims 47, 57, Lewis discloses a system for protecting a person (see fig. 2) from electrostatic discharge (ESD) comprises a computer mouse (see col. 1, lines 1-2), an electrostatic discharge conducting contact element (22) which is located in the computer mouse to be in time-extended contact with a person (12) who is using the computer mouse and who is to be protected from electrostatic discharge when using the computer mouse; a control circuit electrically connected to the contact element, and the control circuit including a first resistor element (24a) having resistance which upon initial contact between the person and the contact element will drain some, but not all, electrostatic discharge form the contact element; an inductor in series with the contact element (see col. 4, lines 6-8); and a ground circuit (26) electrically associated with the control circuit.

Regarding to claims 50, 51, 54, repeat the limitations of claims 1, 3; therefore, rejected accordingly.

3. Claims 34-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Dangelmayer et al. (USPN 5,691,875). Dangelmayer et al. Lewis discloses a system for protecting a person from electrostatic discharge comprises a headphone device (100) an electrostatic discharge conducting contact element which is located in the headphone device in time-extended contact with a person who is using the headphone device and who is to be protected from electrostatic discharge when using the headphone device (see col. 1, lines 43-52); a control circuit electrically connected to the

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contact element, and the control circuit including a first resistor element (see col. 3, lines 30-36) having resistance which upon initial contact between the person and the contact element will drain some, but not all, electrostatic discharge from the contact element; a ground circuit electrically associated with the control circuit (see col. 5, lines 28-31); and the conductive headset pad has a resistance of at least 0.025 megohm (see col. 4, lines 41-43).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis, Jr. et al. (hereinafter Lewis). Lewis discloses a system for protecting a person (see fig. 2) from electrostatic discharge (ESD) comprises an electrostatic discharge conducting contact element (22) which is in time-extended contact with a person (12) who is to be protected from electrostatic discharge when in use; a control circuit electrically connected to the contact element, and the control circuit including a first resistor element (24a) in series with the contact element; a ground circuit (26) electrically associated with the control circuit. Lewis does not disclose the first resistor located within one foot of the contact element. However, Lewis discloses the distance required from the contact element to the resistor (24a) is approximately 0.8 to 1 inch

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(see col. 6, lines 38-42). It would have been an obvious matter of choice to one having ordinary skill in the art to adjust any suitable distance in order to protect electrostatic discharge to the body of a human. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis, Jr. et al. (hereinafter Lewis) in view of Esper (USPN 4,766,903). Lewis discloses all limitations of claim 1 except for having a transistor. Esper discloses a transistor (1). It would have been obvious to one having skill in the art at the time the invention was made to modify the system of Lewis with a transistor as taught by Esper in order to detect voltage or charge carriers on the body of a human.

6. Claims 20, 21, 27- 33, 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis, Jr. et al. (hereinafter Lewis) in view of Johnson (USPN 4,717,349). Lewis discloses all limitations of claim 1 except for having an electrical plug as claimed. Johnson discloses a three prong electrical plug (50), which includes a ground prong, hot prong neutral prong, and female receptacles (see fig. 4). It would have been obvious to one having skill in the art at the time the invention was made to modify the system of Lewis with an electrical plug as taught by Johnson in order to shunt static interference to the ground.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danny Nguyen whose telephone number is (703)-305-5988. The examiner can normally be reached on Mon to Fri 8:00 AM to 4:30 PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (703)-308-3119. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9318 for regular communications and (703)-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0956.

DN

DN  
January 13, 2003



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